Remarks

The Office Action dated January 27, 2003 has been carefully reviewed and the forgoing remarks are made in response thereto. Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims. Applicants respectfully submit that no prohibited new matter has been introduced by the amendments. Support for new claim 50 is found throughout the specification but in particular in original claim 8 as filed. Claim 50 merely restates step (b) of claim 32 as presented before this amendment.

Summary of the Office Action

1. The Examiner has objected to the wording of the priority claim added by the amendment filed April 15, 2002.

2. Claims 32-42 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-9 of U.S. Patent 5,905,027.

3. Claims 32-49 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Response to the Office Action

The specification was objected to as containing new subject matter for use of the language "all of which are hereby incorporated by reference in their entirety" in the new priority data as set forth in the amendment filed April 15, 2002. Applicants have deleted this language from the priority claim and therefore submit that the objection is moot. In view of the amendment to the priority data, Applicants request withdrawal of the objection.

Obviousness-type Double Patenting Rejection

Claims 32-42 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-9 of U.S. Patent 5,905,027. In response to this rejection, Applicants submit the attached terminal disclaimer disclaiming any patent term beyond U.S. Patent 5,905,027. In view of the terminal disclaimer, Applicants respectfully request that the rejection based on the judicially created doctrine of obviousness-type double patenting be withdrawn.

F

Rejection under 35 U.S.C. 112 (second paragraph)

Claim 32 was rejected under 35 U.S.C. 112 (second paragraph) for use of the language "measuring the binding of chlorotoxin in the tissue sample" in step (b) of this claim. The Examiner's courtesy in discussing this rejection with Applicant's agent on May 8, 2003 is acknowledged with appreciation. The Applicants appreciate the Examiner's efforts in furthering the prosecution of this Application. In this regard, Applicants acknowledge the Examiner's indication in a telephone discussion with Applicant's agent on this date that claim 32 if amended to read "detecting the binding of chlorotoxin to the tissue sample" as set forth above would be allowable if entered in an amendment responding to the Office Action. In view of this amendment, Applicants respectfully request withdrawal of the rejection.

Conclusion

Applicants respectfully request reconsideration of the subject application in view of the amendments to the specification and claim. It is respectfully submitted that this application is now in condition for allowance. Should the Examiner find that an interview would be helpful to further prosecution of this application, he is invited to telephone the undersigned at their convenience.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "version with markings to show changes made" as required. If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is required and the fee should be charged to our Deposit Account.

Respectfully submitted
Morgan, Lewis & Bockius LLP

Robert Smyth
Registration No. 50,801

Dated: **May 22, 2003**
Morgan, Lewis & Bockius LLP
Customer No. **09629**
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
202-739-5139

F